REMARKS

Claims 1-20 are pending in the Application. Although no claims have been amended, Applicant has included a current claim listing for the Examiner's convenience.

Rejection under 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,690,915 to Ito et al. ("Ito") in view of U.S. Patent No. 6,339,694 to Komara et al. ("Komara") and further in view of U.S. Patent No. 5,802,452 to Grandfield et al. ("Grandfield").

As the PTO recognizes in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added). Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." Applicant respectfully submits that the combination of Ito, Komara, and Grandfield fails to teach or suggest each element of claims 1-20 as required by MPEP § 2143.

1. Combination of references fails to teach or suggest all claim elements

Claims 1-10

Claim 1 recites in part "adjusting the second gain to equal the first gain."

The Office action relies on Ito (col. 12, lines 20-50 and col. 2, line 35-col. 3 line 28) to render this element of claim 1 obvious. However, the cited text of Ito fails to teach or suggest the above recited element. In fact, Applicant can find no teaching or suggestion of adjusting the second (uplink) gain to equal the first (downlink) gain anywhere in Ito. Furthermore, Komara and Grandfield fail to remedy the deficiency of Ito, as neither Komara nor Grandfield teach or suggest adjusting the second (uplink) gain to equal the first (downlink) gain.

Accordingly, the combination of Ito, Komara, and Grandfield fails to teach or suggest each element of claim 1 as required by MPEP § 2143, and claim 1 is allowable over the cited art.

Claims 2-10 depend from and further limit claim 1 and are allowable for at least the same reason as claim 1.

11-20

Independent claims 11 and 16 each recite an element similar to that described above with respect to claim 1, and are allowable for at least the same reason as claim 1. Claims 12-15 and 16-20 depend from and further limit claims 11 and 16, respectively, and are allowable for at least the same reason as the claim from which they depend.

2. There is no motivation to combine the references

Furthermore, even if the combination of Ito, Komara, and Grandfield taught or suggested each element of each claim (which it clearly does not, as described above), the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000) (emphasis added).

The Examiner states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Grandfield's multiple channel RF repeater automatic gain controller with Komara's mobile repeater sampling power level and with Ito's booster (repeater) noise and gain controller for mobile and base stations ... to provide a telecommunication system repeater with self-adjusting power level controller that is safe to be used with the expensive high power repeater unit ... and 'to provide multiple high data rate channels that can be controlled without generating interference between each channel, while also optimizing the RF output power.'" (Office Action, p. 4).

Applicant submits that the preceding paragraph does not constitute either evidence or particular findings as to why one skilled in the art would combine Ito, Komara, and Grandfield. For example, the Office action admits that Ito fails to teach sampling the power level and comparing the power level to a reference power level, and relies on Komara to teach sampling a power level and on Grandfield to teach comparing the sampled power level to a reference power level. However, Komara focuses on an "invention [that] allows the ALC to be initialized at a safe setting, i.e. at a setting where variations in input signal strength will not result in output amplifier saturation." (col. 3, lines 54-56). The ALC of Komara is directed to protecting an amplifier from being damaged, not with automatically achieving a balance between a coverage area of the repeater and a level of noise associated with the uplink channel. For example, Komara recites that "[w]ith the downlink ALC 704 initialized with a preset attenuation value, the downlink amplifier 706 is protected from being driven into saturation." (col. 10, lines 34-36).

Grandfield is not even directed to an uplink/downlink scenario, but instead describes "[a] multiple channel radio frequency repeater [that] has a receive port for receiving an input signal from a first antenna and a transmit port for transmitting a frequency shifted output signal to a second antenna." In other words, Grandfield is directed to receiving a signal on one frequency and retransmitting the signal on another frequency. (Abstract). Grandfield does not teach or suggest using a sampled power level of the downlink channel, but instead discloses that "[t]he AGC amplifier's output voltage may be used to monitor the quality of the received input signal. Each channel's AGC voltage is compared to a predetermined reference voltage which corresponds to a useful S/N ratio." (col. 2, lines 60-63) (emphasis added). Applicant submits that the generic statement presented in Office action fails to meet the standard of "particular findings" required by the law.

Although Applicant strongly disagrees that the combination of Ito, Komara, and Grandfield teaches or suggests each claim, even if it did, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of

the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01 (emphasis original). Here, not only has the Examiner stated no objective reason to combine the references (as described in the preceding paragraph), but the references fail to even show all aspects of the claimed invention as required (as described in the preceding section directed to § 103).

Therefore, the combination of references is improper and claims 1-20 are allowable over the cited art.

Conclusion

As a result of the foregoing, it is respectfully asserted that claims 1-20 are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 21, 2004.

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